

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 067242/0107

In re patent application of

Fumihiko Watanabe *et al*

Serial No. 09/120,383

Group Art Unit: 1621

Filed: July 22, 1998

Examiner: S. Barts

For: SULFONATED AMINO ACID DERIVATIVES AND METALLOPROTEINASE INHIBITORS CONTAINING THE SAME

OFFICIAL

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.111

Assistant Commissioner for Patents

Washington, D.C. 20231

Sir:

The following is a response to the Office Action mailed November 20, 2000. The Action rejected the claims under 35 U.S.C. 102(e) based on U.S. Patent No. 5,756,545 ("the '545 patent") and requested a certified English translation of PCT/JP97/00126. Applicants have already filed a certified English translation of PCT/JP97/00126, as well as certified English translations of the priority applications JP-30082/96 and JP-213555/96. These certified English translations were filed together with applicants' request for interference and Showing under Rule 608 on May 20, 1999, as evidenced by the enclosed copy of applicants' filing receipt card, which is date-stamped by the PTO. Should the Examiner need new copies of any of these translations, the Examiner is invited to call the undersigned at 202-672-5569.

Also, applicants previously pointed out in their Showing under Rule 608 where the instant claims find support in JP-30082/96, so that they are entitled to an effective filing date of January 23, 1996. A copy of the Showing under Rule 608 filed on May 20, 1999 is also enclosed herewith for the Examiner's convenience.

In view of the foregoing, it is respectfully urged that the present claims are allowable and complete for entry into interference with U.S. Patent No. 5,756,545. An early notice to this effect is earnestly solicited. Should there be any questions regarding this application, Examiner Barts is invited to contact the undersigned at the telephone number shown below.

If there are any fees due in connection with the filing of this Amendment, please charge the fees to our Deposit Account No. 19-0741. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

Dec. 7, 2000

Date


Stephen B. Maebius
Registration No. 35,264

FOLEY & LARDNER
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5109
Telephone: (202) 672-5569

FOLEY & LARDNER

O I P E

67242/107

Receipt is hereby acknowledged of the following:

APPLICANT: Fumihiko Watanabe et al.

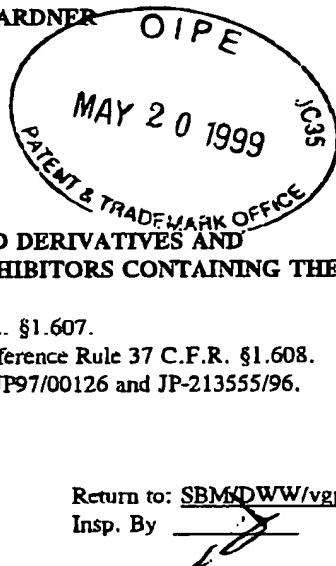
SERIAL NO: 09/120,383

FILING DATE: July 22, 1998

FOR: SULFONATED AMINO ACID DERIVATIVES AND
METALLOPROTEINASE INHIBITORS CONTAINING THE SAME

XX Request for Interference Under 37 C.F.R. §1.607.
XX Showing and Statement Pursuant to Interference Rule 37 C.F.R. §1.608.
xx Certified Translation of JP-30082, PCT/JP97/00126 and JP-213555/96.

XX File in Mail Room.

Date: May 20, 1999Return to: SBMDWW/vgpInsp. By [Signature]

MAP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

ATTY. DOCKET NO. 067242/0107

Fumihiko WANTANABE et al.

Serial No.: 09,120,383

Group Art Unit: 1613

Filed: July 22, 1998

Examiner: Unknown

For: SULFONATED AMINO ACID DERIVATIVES AND METALLOPROTEINASE INHIBITORS CONTAINING THE SAME

**SHOWING AND STATEMENT PURSUANT TO
INTERFERENCE RULE 37 C.F.R. §1.608**Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Further to the Request For Interference Under Rule 607 filed herewith, applicants submit the following statement pursuant to Rule 608(a).

Applicants are entitled to an effective filing date of January 23, 1996, the filing date of the Japanese priority application 30032/96. A certified translation of the priority application is enclosed as Appendix 1. Also enclosed is a certified translation of PCT/JP97/00126, from which the instant application claims priority under 35 U.S.C. §120. The PCT supports the claims as does the instant 09/120,383 application and as set forth in the Rule 607 request. The claims are supported throughout the Japanese Priority document, for example, by claims 1, 7 and 14, and page 9, first full paragraph of the priority document. Thus, the instant application is entitled to the January 23, 1996 filing date.

The effective filing date of U.S. Patent 5,756,546 is its U.S. filing date of April 12, 1997.

Since applicants' effective filing date of January 23, 1996 is earlier than the April 12, 1997 effective filing date of the patent, applicants are *prima facie* entitled to a judgement

U.S. Appln. No. 09/120,383

relative to the patentee. Therefore, it is respectfully requested that an interference be declared.

Moreover, because applicants have an earlier effective filing date, they should be designated as senior party in the interference.

Should the Examiner have any questions, he or she is invited to contact the undersigned.

Respectfully submitted,



Stephen B. Maebius
Reg. No. 35,264

May 14, 1999
Date

FOLEY & LARDNER
3000 K Street, N.W.
Suite 500
Washington, D.C. 20007-5109
Tel: (202) 672-5300

FOLEY & LARDNER
ATTORNEYS AT LAW
WASHINGTON HARBOUR
3000 K STREET, N.W., SUITE 500
WASHINGTON, D.C. 20007-5109
TELEPHONE: (202) 672-5300
FACSIMILE: (202) 672-5399

FAX RECEIVED

UEU U O ZUUU

GROUP 1600

FACSIMILE TRANSMISSION

OFFICIAL

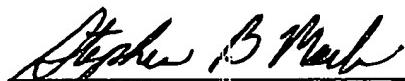
Total # of Pages 6 (including this page)

TO:	PHONE:	FAX #:
Exr. S. Barts Group Art Unit 1621		703-308-4556

From: Stephen B. Maebius
 Sender's Direct Dial: 202-672-5569
 Date: December 7, 2000
 Client/Matter No: 067242/0107
 User ID No: 0473

MESSAGE:

I hereby certify that the enclosed documents are being transmitted to the U.S. Patent & Trademark Office by facsimile on December 7, 2000.


 Stephen B. Maebius

If there are any problems with this transmission or if you have not received all of the pages, please call 202-672-5569.

Operator:	Time Sent:	Return Original To:
		S. Maebius

CONFIDENTIALITY NOTICE: THE INFORMATION CONTAINED IN THIS FACSIMILE MESSAGE IS INTENDED ONLY FOR THE PERSONAL AND CONFIDENTIAL USE OF THE DESIGNATED RECIPIENTS NAMED ABOVE. THIS MESSAGE MAY BE AN ATTORNEY-CLIENT COMMUNICATION, AND AS SUCH IS PRIVILEGED AND CONFIDENTIAL. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT OR ANY AGENT RESPONSIBLE FOR DELIVERING IT TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT YOU HAVE RECEIVED THIS DOCUMENT IN ERROR, AND THAT ANY REVIEW, DISSEMINATION, DISTRIBUTION OR COPYING OF THIS MESSAGE IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE TO US BY MAIL. THANK YOU.

Cover Page 1 of 1